

**REMARKS**

By the present Amendment, Claims 1 and 11 have been amended and Claim 20 has been withdrawn from consideration. Claims 1-19 are now pending in this application. Applicant respectfully requests reconsideration and withdrawal of the rejections in view of the following remarks.

**ELECTION/RESTRICTION**

Examiner has stated that claims 1-19 are under one class and Claim 20 is under a second class and therefore, a restriction is required under 35 U.S.C. § 121. The restriction is respectfully traversed as claims 1-20 are directed to a single invention. Further, examination of the claims to the device and method pose no additional burden upon the examiner. To expedite prosecution however, Applicant wishes to prosecute the invention of Claims 1-19.

**DRAWINGS**

Examiner rejected the drawings under 37 U.S.C. § 1.83(a). Examiner has stated that the "housing member of textile woven flexible material" as stated in Claims 4 and 14 is not shown in the drawings. However, Claims 4 and 14 state "said housing member is comprised of textile woven flexible material". The referenced housing member is disclosed in the drawings as number 28. See Figures 1, 4a and 4b, and Detailed Description page 7, line 15, page 9, lines, 8, 9, 15, and 17-19, and page 10, lines 1, 3, 6, 10, and 12. For example, an elastic synthetic material such as nylon would likely be considered by most skilled in the art to be a textile woven flexible material. Such a material would could certainly fit the details shown as the referenced

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housing member disclosed in the figures as number 28. Given the clarification, Applicant respectfully requests that Examiner withdraw the objection to the drawings under 37 U.S.C. § 1.83(a).

#### SPECIFICATION

Examiner has rejected the title as being non descriptive. The Examiner is respectfully reminded that shoes are a form of footwear and therefore the title is descriptive. Applicant respectfully requests the Examiner to withdraw the objection to the title of the invention.

Examiner has rejected the specification for failing to provide proper antecedent basis for the claimed subject matter. The specification has been amended to disclose the housing member being made of rigid plastic material, textile woven flexible material, or leather material. Therefore, Applicant respectfully requests the Examiner to withdraw the objection to the specification.

#### CLAIM REJECTIONS--35 U.S.C. 112, FIRST PARAGRAPH

Examiner rejected Claims 10 and 11, under 35 U.S.C. § 112 first paragraph, as failing to comply with the enablement requirement. The specification has been amended to more clearly explain how the tool portion is capable of inserting or creating a hole in the shoe heel. Given the amendment, Applicant respectfully requests that Examiner withdraw the rejection of Claim 10 and 11 based on § 112, first paragraph.

#### CLAIM REJECTIONS--35 U.S.C. 112, SECOND PARAGRAPH

Examiner rejected Claims 8 and 18 under 35 U.S.C. § 112 second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention as it is unclear as the particular meaning of rope material. Rope material is a commonly understood term in the art. Rope is a very common word and Applicant respectfully references the dictionary titled Merriam Webster which defines rope as "a large stout cord of strands of fibers or wire twisted or braided together." Therefore, rope material would be defined the same. Applicant respectfully requests that Examiner withdraw the rejection of Claim 1-16 and 20 based on § 112, first paragraph.

CLAIMS REJECTIONS – 35 U.S.C. §102

Examiner rejected Claims 1 and 8 under 35 U.S.C. §102(b) as being anticipated by *Sittman* (U.S. Patent No. 3,936,063). This rejection is respectfully traversed. As discussed below, *Sittman* fails to teach each and every element of the rejected claims.

Such rejection under §102 for anticipation requires that the single reference teach each and every element or step of the rejected claim. *See, Atlas Powder v. E.I. DuPont*, 750 F.2d 1569 (224 USPQ 409) (Fed. Cir. 1984). Examiner's rejections under §102 fail to meet this test.

*Sittman* does not disclose "quick release members . . . having an engaging barrel portion and a heel barrel portion." or a "pair of securing members a respective one of said pair having a receiving barrel portion. . . whereby one of said receiving barrel portions is permanently located inside a footwear to be carried and adaptably receives said engaging barrel portion" as stated in Claim 1. This limitation is nowhere found in *Sittman* or, for that matter, in any of the prior art cited by Examiner.

Further, none of the prior art discloses the limitation that the receiving barrel portion is permanently located inside the footwear to be carried. The device shown in *Sittman* does not provide for any portion of the retaining mechanism to be located within the footwear. In addition,

the device shown in *Sittman* requires several steps to engage and disengage the retaining mechanism. Applicant's invention only requires the engaging barrel portion to be mated with the receiving barrel portion to engage and the engaging barrel portion to be removed from the receiving barrel portion to disengage. Therefore, unlike Applicants' invention, *Sittman* is not designed for quick and easy installation and removal. Claim 8 depends from Claim 1. Therefore, Applicant respectfully request that Examiner withdraw the rejection of Claims 1 and 8 under 35 U.S.C. §102(b).

Examiner rejected Claims 1, 8, 10, and 11 under 35 U.S.C. §102(b) as being anticipated by *Matsushita* (5,785,223). The device in *Matsushita* is made to fit inside the foot entry point of a boot. See Abstract and figures generally. The preset invention may be located almost anyplace on the footwear that the securing member may be attached. In addition, *Matsushita* does not disclose "quick release members . . . having an engaging barrel portion and a heel barrel portion." or a "pair of securing members a respective one of said pair having a receiving barrel portion. . . whereby one of said receiving barrel portions is permanently located inside a footwear to be carried and adaptably receives said engaging barrel portion " as stated in Claim 1 and claim 11. Because *Matsushita* does not teach of a barrel portion permanently located inside a footwear and adaptably received an engaging barrel portion, *Matsushita* fails to teach each and every element of the rejected claims and Applicant respectfully request that Examiner withdraw the rejection of Claims 1, 8, 10, and 11 under 35 U.S.C. §102(b)

#### CLAIM REJECTIONS--35 U.S.C. 103

Examiner rejected Claims 3-7 and 9-19 under 35 U.S.C. § 103(a) as being unpatentable over *Sittmann* in view of *Schwartz* (5,255,947). This rejection is respectfully traversed.

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One of ordinary skill in the art at the time of the invention would not have made the design modifications to the device in *Sittmann* as alleged by Examiner. As stated above, *Sittman* does not disclose "quick release members . . . having an engaging barrel portion and a heel barrel portion." or a "pair of securing members a respective one of said pair having a receiving barrel portion. . . whereby one of said receiving barrel portions is permanently located inside a footwear to be carried and adaptably receives said engaging barrel portion" as stated in Claim 1 and, unlike Applicants' invention, *Sittman* is not designed for quick and easy installation and removal

Essentially, one of ordinary skill in the art would not be inclined to modify the device of *Sittman* in view of *Schwartz* and be able to create the present invention. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). *Schwartz* provides a lifting device for a water bottle. A water bottle is considerably heavier than footwear. Also, the device in *Schwartz* is for lifting the water bottle a relatively short distance and is not for carrying the water bottle an appreciable distance. Neither *Sittman* nor *Schwartz* have any teaching, suggestion, or motivation for modifying the devices disclosed in *Sittman* or *Schwartz* to be able to create the present invention. Therefore, the rejection lacks proper basis and should be withdrawn.

For the reasons stated above and because Claims 3-7, 9 and 10 depend from Claim 1 and


Claims 12-19 depend from Claim 11, which should now be deemed allowable, Examiner is respectfully requested to withdraw the rejections made to Claims 3-7 and 9-19 under 35 U.S.C. § 103.

**CONCLUSION**

Given the arguments presented above, Applicants submit that Claims 1-20 are now in condition for allowance. Therefore, Applicants respectfully request that Examiner withdraw all rejections to the above-referenced claims. If there are any outstanding issues that the Examiner feels may be resolved by way of a telephone conference, the Examiner is cordially invited to contact Steven B. Leavitt at (972) 412-2671.

Respectfully submitted,

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